



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,404	05/14/1999	JOHN MAURICE BIRD	MARSP0114US	2564

7590 11/06/2002

NEIL A DUCHEZ ESQ
RENNER OTTO BOISSELLE & SKLAR PLL
1621 EUCLID AVENUE NINETEENTH FLOOR
CLEVELAND, OH 44115

EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
----------	--------------

3729

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M

Office Action Summary

Application No.

09/312,404

Applicant(s)

BIRD ET AL.

Examiner

Dexter Tugbang

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 17-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 12 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed on 7/10/02 (Paper No. 25) has been fully considered and made of record.

Election/Restrictions

2. Claims 7-11 and 17-20 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 13.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication 153,131, referred to hereinafter as EP'131.

EP'131 discloses a method of manufacturing a coil for a magnet comprising:
manufacturing a former from a flexible material to form a flexible former 12 (see page 2, lines 13-23); and disposing a hard-wire electrical conductor (coils 10, 11) around the flexible former (shown in Fig. 2). It is noted that the American Heritage Dictionary (3rd edition, 1992) defines the terms of *flexible* as "capable of being bent or flexed" and *resilient* as "capable of returning to

Art Unit: 3729

an original shape, after having been compressed". The former of EP'131 is clearly bent or flexed into a cylindrical shape and is certainly capable of returning to its original position of being flat. Therefore, the flexible former of EP'131 can be said to be *resilient*.

Regarding Claim 21, being that the former 12 of EP'131 is flexible, it can also be said to be an "elastomer material", since the flexibility enables the former to behave as a rubber like material.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'131 in view of Japanese Patent Publication JP 61-79214, referred to hereinafter as JP'214.

EP'131 discloses the claimed manufacturing method as previously discussed and further including that the former is made from a flexible epoxy fiberglass sheet (see bottom of page 2). EP'131 does not teach that the former is formed of a rubber material or a flexible epoxy resin.

JP'214 shows that a former 5 can be made of a rubber material to provide an elastic nonconducting material and electrically insulated the windings (see Purpose).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the former of EP'131 with a rubber material, as taught by JP'214, to advantageously provide a nonconducting material and insulate the windings.

Regarding Claim 23, it would have been an obvious matter of design choice to choose any desired flexible epoxy material since the applicants' have not disclosed that the claimed flexible epoxy resin solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the flexible epoxy material taught by EP'131.

Response to Arguments

7. Applicant's arguments filed 7/12/02 have been fully considered but they are not persuasive. In regards to the merits of EP'131, the applicants' contend that the former of EP'131 is not resilient because the former is not capable of returning to its original position.

The examiner most respectfully disagrees. The applicants' are referred to the abstract of EP'131, which recites among other things, that "a flexible sheet so that it can be bent into any desired shape to create a complex magnetic...". The phrase any desired shape would include the former's original shape or original position. Thus, the examiner maintains that the former of EP'131 is resilient.

Allowable Subject Matter

8. Claims 1-6 and 13-16 are allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3729

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Dexter Tugbang
Examiner
Art Unit 3729

adt
November 4, 2002